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To: USPTO, Examiner Gabel

From: Coe F. Miles

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Pages: 7 (incl cover)

Date: July 6, 2005

Customer No.: 29664

Re: Reply Brief SN: 09/550,276

☐ Urgent

☐ For Review

☐ Please Reply

☐ For Comment

Comments: Please find attached the following:

1. Transmittal Letter (1 page); and
2. Reply Brief (5 pages).

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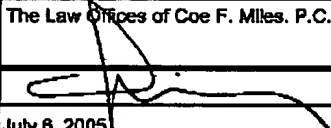
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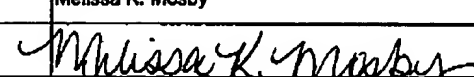
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/550,276	
	Filing Date	April 15, 2000	
	First Named Inventor	Glenn Spaulding	
	Art Unit	1841	
	Examiner Name	Gailene Gabel	
Total Number of Pages in This Submission	7	Attorney Docket Number	010-US-002

ENCLOSURES (Check all that apply)		
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Firm or Individual name	The Law Offices of Coe F. Miles, P.C.
Signature	
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Typed or printed name	Melissa K. Mosby
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Date	July 6, 2005

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Title : Novel Flow Cytometer
Inventors : Glenn Spaulding
Serial No : 09/550,276 § Examiner : Gailene Gabel
Filed : 15 April 2000 § Phone : 571-272-0820
Docket : 010-US-002 § Art Unit : 1641
Customer : 29664

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Melissa Mosby

REPLY BRIEF

This is a Reply Brief filed in response to the Examiner's Answer mailed on 3 June 2005 for the above-identified matter. The Examiner's Answer was generated in response to the Appellant's Appeal Brief filed 17 March 2005.

Reply Brief

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1. Real Party in Interest

The real party in interest was identified in Appellant's Appeal Brief filed on 17 March 2005 and acknowledged in the Examiner's Answer. See Examiner's answer at page 2.

2. Related Appeals and Interferences

Related appeals and interferences were identified in Appellant's Appeal Brief filed on 17 March 2005 and acknowledged in the Examiner's Answer. See Examiner's answer at page 2.

3. Status of Claims

The Examiner has agreed with Appellant's statement regarding the status of pending claims. See Examiner's answer at page 2.

4. Status of Amendments

The Examiner has agreed with Appellant's statement regarding the status of amendments after the Examiner's Final Office Action. See Examiner's answer at page 2.

5. Summary of the Claimed Invention

The Examiner has agreed with Appellant's statement regarding the summary of the claimed invention. See Examiner's answer at page 2.

6. Grounds of Rejection to be Reviewed on Appeal

The Examiner has agreed with Appellant's statement regarding the grounds of rejection to be reviewed on appeal. See Examiner's answer at page 2.

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7. Grouping of Claims

The Appellant concurs with the Examiner that pending claims 1-4, 10, 11, 13-31, 33 and 34 stand or fall together. *See Examiner's answer at pages 2-3.*

8. Claims Appealed

The Examiner has agreed that Appellant's Appeal Brief includes a correct copy of appealed claims 1-4, 10, 11, 13-31, 33 and 34. *See Examiner's answer at page 3.*

9. Prior Art of Record

Appellant agrees with the Examiner's identification of the Prior Art of Record. *See Examiner's answer at page 3.*

10. Rejections Withdrawn

Appellant acknowledges the Examiner's withdrawal of her section 112, second paragraph, rejections with respect to dependent claim 2. *See Examiner's answer at pages 3-4.*

11. Comment Regarding the Examiner's Rejection of Claims 1, 2, 10, 11, 21, 33 and 34 Under 35 U.S.C. Section 102

The Examiner continues to reject claims 1, 2, 10, 11, 22, 23, 33 and 34 over US patent 5,582,795 to Nishina et al. ("Nishina") for anticipation under 35 U.S.C. 102. *See Examiner's Answer at page 5.* To support this rejection the Examiner alleges that reading a barcode affixed to a sample container is equivalent to the recited "determining means for determining at least one cytometric characteristic of a sample disposed in said transparent cylinder based on said light signal." *See Examiner's Answer at page 4 and pending independent claims 1 and 10.*

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The language of the pending claims is clear. The recited light source is used to interrogate the contents of a spinning sample container. *See* pending independent claims 1 and 10. This interpretation is supported by the application's written description and dependent claim 2 which explicitly identifies the action of reading a bar code affixed to an outer wall of the sample container – thereby distinguishing the claimed subject from that of simply reading a bar code. Accordingly, and as previously argued by Appellant, the act of reading a bar code affixed to an outer surface of a container is not equivalent to the act of determining a cytometric characteristic of a sample disposed in the container. Appellants additional prior remarks concerning Nishina are hereby adopted in full. *See* Appeal Brief at pages 11-12.

12. Comment Regarding the Examiner's Rejection of Dependent Claims 3, 4, 13-20 and 23-30 Under 35 U.S.C. Section 103

Appellants prior remarks concerning the Examiner's section 103 rejection of dependent claims 3, 4, 13-20, 23-30 are hereby adopted in full. *See* Appeal Brief at page 13.

13. Comment Regarding the Examiner's Notice of Allowable Subject Matter

The Examiner indicates that pending independent claims 1 and 10 may be allowable had Appellant adopted the Examiner's suggested claim language amendment. *See* Examiner's Answer at pages 10-12.

Appellant did not decline the Examiner's offer lightly, as an attempt to prolong prosecution or without cause. Appellant declined the offer for at least the following two reasons. First, the recited claim language already distinguishes the cited prior art. Second, twice before during prosecution of this matter the Examiner has made similar offers and twice before Appellant has accepted. In both cases, the Examiner determined that it was in the Office's best interest to reopen examination rather than

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granting allowance. Appellant accepts without complaint the Examiner's determination and has continued prosecution of this matter in good faith.

While neither prior amendment could be said to significantly limit the scope of the claimed subject matter, the amendments were made. As the Board is undoubtedly aware, current case law teaches that *any* amendment not absolutely required to distinguish the prior art can have significant detrimental effects on the value of a subsequently issued patent. None of the Examiner's suggested amendments are *required* to distinguish the prior art. Accordingly, Appellant respectfully declines to make further unnecessary amendments.

Respectfully submitted,

6 JULY 2005
Date


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